

REMARKS

This responds to the Office Action mailed on December 12, 2007.

Claims 1, 12, 21 and 22 are amended, no claims are canceled, and no claims are added; as a result, claims 1-2, 12-18, 21-22, 25 and 27-31 remain pending in this application.

§103 Rejection of the Claims

Claims 1-2, 4-10, 12-18, 20-25, and 27-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zeller (U.S.20040111431) in view of Oster (U.S. 20030191806).

The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion, that a claim is obvious within § 103(a), depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966): (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested, by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ; MPEP § 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ; MPEP § 2143.03. As part of establishing a *prima facie* case of obviousness, the Examiner's analysis must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* To facilitate review, this analysis should be made explicit. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ____ (2007)(slip opinion at 14)(citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

The court in *Fine* stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so."

Id. (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

MPEP § 2142.

The test for obviousness under §103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir.1985). The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990). The fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art. *Stranco Inc. v. Atlantes Chemical Systems, Inc.*, 15 USPQ2d 1704, 1713 (Tex. 1990). When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *KSR Int'l Co.*, 550 U.S. ____ (2007)(slip opinion at 12)(citing *United States v. Adams*, 383 U.S. 39, 51-51 (1966)).

Further, the Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *See KSR Int'l Co.*, 550 U.S. ____ (2007)(slip opinion at 14)(citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)); *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Finally, the Examiner must avoid hindsight. *In re Bond* at 834.

Additionally, there must be a rational underpinning grounded in evidence to support the legal conclusion of obviousness. *See In re Kahn*, 78 USPQ2d 1329 (Fed. Cir. 2006), which states that, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn* citing *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002). Additionally, "mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole." *In re Kahn*.

As noted above, claims 1-2, 4-10, 12-18, 20-25 and 27-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US 20040111431 (hereinafter Zeller) in view of US 20030191806 (hereinafter Oster). Claims 1, 12, 21 and 22 are amended. The pending claims, currently and as amended, do distinguish over the references cited by the Examiner.

The language added in the response to the previous Office Action clarified the definition of data sources to make it clear that the data sources are disparate data sources. This is supported in a number of places in the specification (see, for instance, the discussion of Figs. 7 and 10-13). None of the references cited describe extracting data from two or more disparate data sources, as described by Applicant and claimed in each of the pending claims. That the data sources are, indeed, different is underscored by the fact that at least one different category of information is stored in each data source.

In contrast, as noted at [31], Zeller extracts his organization information from a single database. Zeller does not even recognize that it may be necessary to extract organization information from two or more disparate data sources. This necessity was recognized by Applicant and a method for extracting such information was described by Applicant and claimed in claims 1-2, 4-10, 12-18, 20-25 and 27-31.

The Examiner suggested that the idea of extracting organization information from a plurality of independent sources was shown in Oster at [27]. Applicant carefully reviewed paragraph [27] and is unable to see two different sources for the organization information. Instead, an org-chart database 212 stores organization information while organization table 214 extracts some or all of that information for use in generating mailing and access lists. It would be difficult to find that org-chart database 212 and organization table 214 are “disparate” as required by claims 1-2, 4-10 and 21. Claims 1 and 21 have been amended to make it even more clear that what we are claiming is the extraction of information from two or more disparate data sources. Similarly, claims 12 and 22 haven been amended to make it even more clear that what we are claiming is the extraction of information from two or more independent data sources.

In addition, claims 1 and 21 have been amended to show how business operations data such as customer assignment data or customer interaction data is mapped to the hierarchy to create a hierarchy that highlights particular business functions. As noted at Figs 8 and 9 and described at p. 11, line 27 – p. 12, line 20, cost actuals per customer can be mapped on the hierarchy to detect unexpected or abnormal cost actuals. The same approach can be used to display the people in the hierarchy whose clients pay late, etc. There is no equivalent function in any of the references cited by the Examiner.

This additional functionality can be understood in the discussion of “linking”in, for instance, claim 12. Applicant has more clearly defined what Applicant means by “linking”. None of the cited references detail “linking employees as a function of the organization information to form a hierarchy of employees and locating the users within the hierarchy of employees, wherein linking includes mapping information from each of the organization information data sources to first categories and storing the mapping in an info set, wherein at least one category present in the first data source is not present in the second data source” as described by Applicant and claimed in each of the pending claims. This is a different approach from that described by Zeller.

Applicant respectfully requests withdrawal of the rejections and reconsideration and allowance of claims 1, 2, 12-18, 21, 22, 25 and 27-31.

In his rejection of claim 21, the Examiner stated that Zeller teaches delivering user specific reports as a function of the user's place in the hierarchy. Applicant is unable to see this teaching in Zeller or Osterberg. Clarification is requested.

The Examiner also stated that Zeller teaches filtering each user's report as a function of threshold information and the user's place in the hierarchy. Applicant is also unable to see this teaching in Zeller or Osterberg. Clarification is requested.

In his rejection of claims 28 and 30, the Examiner stated that Osterberg discloses "wherein generating includes aggregating data extracted from the third data sources (See paragraph 0027)." All the data extracted in Osterberg is taken from a single database (org-chart database 212). Therefore, Osterberg does not teach "wherein generating includes aggregating data extracted from the third data sources."

In his rejection of claims 29 and 31, the Examiner stated that Osterberg discloses "wherein one of the first categories is a conditions on notification category associated with each user and wherein generating includes delivering a report as a function of information in the conditions on notification associates with each user (See paragraph 0037)." Paragraph 37 of Osterberg, however, describes an email messaging system that delivers an email message to a list of generated email addresses. There are no "conditions of notification" as required by claims 29 and 31.

Applicant respectfully requests withdrawal of the rejections and reconsideration and allowance of claims 1, 2, 12-18, 21, 22, 25 and 27-31.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6909 to facilitate prosecution of this application.

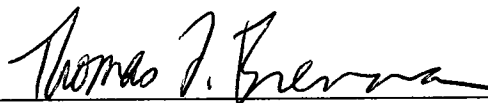
If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date November 14, 2008

By

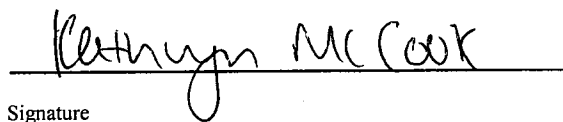


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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop RCE, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 14th day of November, 2008.

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Name


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